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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,952	02/06/2004	Katja Peter	LWEP:122US	7353
24041 7590 08/19/2008 SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406				
EXAMINER				
CONSILVIO, MARK J				
ART UNIT		PAPER NUMBER		
2872				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,952

Applicant(s)

PETER ET AL.

Examiner

Mark Consilvio

Art Unit

2872

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 4-13 and 16-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 4-13 and 16-30 are withdrawn. Claims 1-3, 14, 15, and 31 were previously rejected and claims 1, 2, and 14 are newly amended. Claim 31 has been cancelled. Claims 1-30 are currently pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by Sato (US Patent No. 5,000,555) or, in the alternative, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US Patent No. 5,000,555) in view of Kojima (US Patent No. 5,703,714)

Sato discloses a device for controlling functions of a microscope within a microscope system, said device comprising: a stand base portion (1a) holding a microscope within the microscope system, a central display (41) integrated into the stand base portion, wherein the central display can be used to perform a plurality of settings of the microscope within the microscope system, where the plurality of settings that can be performed includes at least one of objective selection and secondary magnification selection (fig. 5A and col. 3, lines 24-44). Though Sato does not explicitly teach that the central display can be used to call saved settings

of the microscope within the microscope system and to receive warning messages or notifications from the microscope within the microscope system, it does not appear that any additional structure is required by these limitations.

However, should it be determined that some additional structure is implied by these limitations, the following obviousness rejection also applies: As noted above, Sato does not expressly disclose all the functions the display can be used to perform. Kojima teaches a touch-screen display that can be used to perform a plurality of settings of the microscope within the microscope system (i.e. magnification selection, observation method selection, etc...), to call saved settings of the microscope within the microscope system (e.g. see col. 6, lines 56-63) and to receive warning messages or notifications from the microscope within the microscope system (e.g. see fig. 26) where the plurality of settings that can be performed includes at least one of objective selection and secondary magnification selection (abstract) (see also figs. 1-15). Thus, the known technique of using a display to perform various functions including calling saved settings, receiving notifications, setting objective selection, etc... was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying this known technique to the known device (i.e. the microscope of Sato) that was ready for improvement and the results would have been predictable to one of ordinary skill in the art. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to apply the known technique of Kojima to achieve the claimed invention and the modification would have the yielded predictable result of a microscope display with additional microscope control functions. See *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) and *Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976).

Claims 2, 3, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US Patent No. 5,000,555) in view of Kojima (US Patent No. 5,703,714)

With respect to claims 2 and 3, Sato does not disclose the display to display main, sub-main, and submenus. However, this type of “nested” menu structure is very well known in the prior art and commonly used in display systems. See, e.g., the teachings of Kojima (figs. 10-12). Kojima also discloses the display contains an operating menu and an information mode, the operating menu being constructed from a first region (330), a second region (310), and a third region (320), and a main menu being displayable in the first region, a submenu in the second region, and information and action elements (321, 322) in the third region, the third region being delimited on one side by the main menu and on one side by the submenu, and the entire display being usable for presentation in the information mode (fig. 10). Kojima further discloses a main menu (e.g. fig. 10) is constructed from multiple sub-main menus (300, 310, 320, etc...); and depending on the selection of the sub-main menu (i.e. 300) by the user, a respective submenu (e.g. fig. 11) corresponding to the selected sub-main menu is displayable on the display. At the time of the invention, it would have been obvious to use such a menu structure including these types of menus in Sato’s microscope system in order to organize the information and control systems, thus making them easy to use.

Claims 1-3, 14, and 15 are rejected under 35 U.S.C. 102(b) as anticipated by Kojima (US Patent No. 5,703,714) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kojima (US Patent No. 5,703,714) in view of Sato (US Patent No. 5,000,555).

With respect to claim 1, Kojima discloses a device for controlling microscope functions of a microscope within a microscope system, said device comprising: a stand base portion holding a microscope within the microscope system (not shown), a central display (101, 102) integrated into a stand base portion (i.e. whatever element supports the display), wherein the central display can be used to perform a plurality of settings of the microscope within the microscope system (i.e. magnification selection, observation method selection, etc...), to call saved settings of the microscope within the microscope system (e.g. see col. 6, lines 56-63) and to receive warning messages or notifications from the microscope within the microscope system (e.g. see fig. 26) where the plurality of settings that can be performed includes at least one of objective selection and secondary magnification selection (abstract) (see also figs. 1-15).

The previous rejection of claim 1 by Kojima is appropriate under 35 U.S.C. 102(b). However, if a more narrow reading of the limitation of *a central display integrated into a stand base portion* is taken (i.e. the display is located in the base of the stand supporting the optical elements of the microscope), then Kojima does not expressly disclose a central display integrated into a stand base portion (though clearly the optical elements of Kojima must have a housing to support the optical elements including a stand base portion). However, Sato discloses a microscope having a central display (41) integrated into a stand base portion (1a) of the microscope (fig. 4B). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to integrate the display of Kojima into the stand base portion of Kojima to achieve the claimed invention because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded predictable

results. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson 's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

With respect to claims 2 and 14, Kojima discloses, in addition to the features of claim 1, the display contains an operating menu and an information mode, the operating menu being constructed from a first region (330), a second region (310), and a third region (320), and a main menu being displayable in the first region, a submenu in the second region, and information and action elements (321, 322) in the third region, the third region being delimited on one side by the main menu and on one side by the submenu, and the entire display being usable for presentation in the information mode (fig. 10).

With respect to claims 3 and 15, Kojima discloses a main menu (e.g. fig. 10) is constructed from multiple sub-main menus (300, 310, 320, etc...); and depending on the selection of the sub-main menu (i.e. 300) by the user, a respective submenu (e.g. fig. 11) corresponding to the selected sub-main menu is displayable on the display.

Response to Arguments

Applicant's arguments filed 04/30/2008 have been fully considered but they are not persuasive.

First, it is noted that, pursuant MPEP § 2112, where applicant claims an apparatus in terms of a function, property, or characteristic but it is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103

rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

Second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Third, in response to applicant's argument that the Kojima reference fail to teach or suggest certain claimed limitations, it is noted that the limitation(s) upon which applicant relies (i.e., *a stand base portion*) must be given their broadest reasonable construction as would be interpreted by one of ordinary skill in the art. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). It is the examiner's position that the disclosure of Kojima would have reasonably implied to one of ordinary skill that the microscope system of Kojima would include a support structure of conventional arrangement (i.e. "a stand"). Typically, one would view the portion including the condenser, illumination section, and stage as "the base." Combined with (i.e. integrated into) this stand base portion is a display 101, 102 via wiring or the like.

And fourth, in response to applicant's argument that the Sato reference teaches away from the proposed combination, the examiner recognizes that a prior art reference must be considered

in its entirety, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See also MPEP § 2123.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Thursday, 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/M. C./
Examiner, Art Unit 2872

/Alessandro Amari/
Primary Examiner, Art Unit 2872